

REMARKS

I. Introduction

Claims 1, 3-10 and 12 remain pending, with claims 1 and 10 having been amended herein.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are in allowable condition.

II. Rejection of Claims 1, 3-8, 10 and 12 under 35 U.S.C. § 103(a) based on Whetsel

Claims 1, 3-8, 10 and 12 have been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,408,413 to Whetsel ("Whetsel").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

In the Final Office Action, the Examiner contends that the claims (as previously submitted) do not refer to the feature that the JTAG interface need not be externally accessible. While the necessity of explicitly incorporating this language into the claims is not admitted, Applicants have amended independent claims 1 and 10 to recite that the I/O ports of the microprocessor are connected to pins of the JTAG interface, and a data-in pin of the JTAG interface is activated using the test routine via the I/O ports, *such that the boundary scan test procedure may occur without external access to the JTAG interface*. With regard to the Examiner's assertions that "it is not clear how such a limitation would result in any tangible structural change," Applicants respectfully submit that this limitation is structural in that it indicates that the I/O ports of the microprocessor and the pins of the JTAG interface can be mutually interconnected in such a way that no external device needs to be coupled the pins of the JTAG interface. For example, the lines of the microprocessor and JTAG interface may be connected and occupied in such a way that there are no available ports for either an

external input or for an output to an external device. As discussed in the previously filed response of August 20, 2004, this feature distinguishes the claimed invention from the teachings of the Whetsel reference in which a TAG interface receives data from an external source (i.e., not the microprocessor) and similarly outputs data to an external device.

For these reasons, it is submitted that claim 1 and its dependent claims 3-8 are not anticipated by Whetsel.

Since claim 10 has been amended similarly to claim 1, it is submitted that claim 10 and its dependent claim 12 are also not anticipated by Whetsel.

Withdrawal of the anticipation rejection of claims 1, 3-8, 10 and 12 is therefore respectfully requested.

III. Rejection of Claim 9 under 35 U.S.C. § 103(a)

Claim 9 has been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Whetsel in view of U.S. Patent No. 5,357,432 to Margolis ("Margolis").

Claim 9 depends from, and incorporates the limitations of, claim 1. The Margolis reference merely refers to an automatic guidance control system that includes a microcontroller. Margolis does not in any way refer to a boundary scan procedure according to IEEE 1149, let alone refer to specific ways of implementing such a procedure. As such, Margolis fails to cure the critical deficiencies of the primary Whetsel reference discussed above with respect to claim 1. Therefore, the combination of Whetsel and Margolis does not render obvious the features of claim 9, which incorporates the features of claim 1.

Withdrawal of the obviousness rejection of claim 9 is therefore respectfully requested.

CONCLUSION


In light of the foregoing, Applicants respectfully submit that all of the pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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